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15. (NEW) The display device of claim 10 wherein the distance between said translucent panel and said opaque surface or panel is between 31.8 millimeters (1.25 inches) and 88.9 millimeters (3.5 inches).

16. (NEW) The display device of claim 15 wherein said translucent panel is affixed to said opaque surface or panel by a plurality of stand-off mounts.

17. (NEW) The method of reducing the effect of shadows on items in display devices consisting of:

utilizing an opaque surface or panel;

positioning a translucent panel substantially parallel to said opaque surface or panel, such that the distance between said opaque surface or panel and said translucent panel is between 1 and 185 millimeters (.04 to 7.3 inches), said translucent panel having a frosted acrylic structure throughout and of approximately the same or less area as said opaque surface or panel.

18. (NEW) The method of claim 17 further including the step of providing item support means affixed to said translucent panel on the surface remote from the area between the translucent and opaque panels.

19. (NEW) The method of claim 18 further including the step of providing a light source with fastening and positioning means whereby display items positioned on said item support means are illuminated by said light source.

20. (NEW) The method of claim 19 further including the step of positioning said translucent panel substantially parallel to said opaque surface or panel, such that the distance between said opaque surface or panel and said translucent panel is between 31.8 millimeters (1.25 inches) and 88.9 millimeters (3.5 inches).

21. (NEW) The method of claim 20 further including the step of adapting said item support means to contain support members for displaying eyewear.

REMARKS

The last Office Action dated 8/9/2005 has been carefully considered.

It is noted that **Claims 1-5** have been canceled in view of the last Office Action without prejudice or disclaimer of the subject matter contained therein. **Claims 1-5** were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The alternate language "and/or" used in **Claims 1-5** has been eliminated. It is believed that the above amendments to the claims are fully responsive to the Examiner's rejection, in that **Claims 1-5** have been canceled and the alternate language eliminated.

It is noted that Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shofu (U.S. Pat. No. 4,184,194) in view of Detiker (U.S. Pat. No. 3,694,945). Examiner states that "It would have been obvious to an ordinary skill in the art at the time the invention was made to modify the display device of Shofu by substituting a frosted translucent panel in order to provide differing light effects in the dark when illuminated and in daylight when the light source is not in use."

There is no suggestion in the references that they be combined.

Shofu discloses a high intensity light device for illuminating x-ray and photographic images utilizing an internal light source. There is absolutely no application of the Shofu patent that would necessitate providing "differing light effects in the dark when illuminated and in daylight when the light source is not in use." In Shofu, the high intensity light source is necessary to view the x-ray and photographic images. There is no suggestion that the Shofu device would be used without a high intensity light source, i.e., "in daylight when the light source is not in use".

In Detiker the inventor sought to provide differing light effects in the dark and the daytime for his optical element used in lighting, decorating, signaling and advertising. The Examiner appears to be inappropriately projecting a need to the Shofu patent based on unrelated isolated teachings from the Detiker patent. That a cited art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989). Also, the Examiner may not use isolated teaching from the references. (see *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986)) MPEP 2141.02.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.).

The nature of the problem solved by the present invention is the reduction or elimination of shadows in display devices. This problem is not addressed in the Shofu or Detiker patents. As noted previously, the teachings of the cited art do not provide a source for motivation to combine references. As to the knowledge of persons of ordinary skill in the art, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). MPEP 2143.01.

The features as claimed are not found in either Shofu or Detiker (and therefore could not be found in the combination) and the combination could not realize the advantages or benefits of the claimed invention.

The present invention claims use of a frosted acrylic panel that is frosted throughout its acrylic structure. Shofu does not make mention of a frosted material of any sort. Detiker makes use "of a material which transmits light but has been slightly frosted." (col. 3, lines 2-3.) The present invention makes use of a translucent material that is frosted throughout its acrylic structure. This material was found to be the most suitable in reducing the effects of shadows in display devices. The use of a translucent material that is frosted throughout its acrylic structure is not found in either the Shofu or the Detiker references. Thus, the combination of references could not realize the advantages and benefits of the claimed invention by reducing shadows on the translucent panel of the display.

Further, both the Shofu and Detiker cited art involve an internal light source that is placed between the translucent and opaque surfaces or panels. The present invention as claimed does not include an internal light source. The shadow reduction capability of the display device is based in part on the fact that there is nothing between the translucent and opaque surfaces or panels. The presence of an internal light source would not afford the benefits of the claimed invention.

The Shofu and Detiker references teach away from the claimed invention.

Applicants believe that Shofu and Detiker both teach a much more complex invention than the invention of the present application, by focusing on complex embodiments such as that claimed in the 4,184,194 and 3,694,945 patents. Thus, applicants believe that Shofu and Detiker teach away from the simplicity of the present invention which provides a solution to the problem of reducing the effect of shadows on display devices with a minimum of manufacturing steps by elimination of an internal light source. See *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) (prior art reference "appears to teach away from the selection of" the claimed composition "by focusing on more complex examples").

Shofu and Detiker utilize an internal light source that is necessary:

- 1) in Shofu to illuminate the x-ray or photographic images against the translucent panel and provide a device "capable of producing high intensity light" (col. 1, line 8-9), and
- 2) in Detiker to have a lighted body which provides a strong brightness contrast to its surroundings in the dark (col. 1, lines 8-10).

New claim 7 claims a display device without an internal light source between the translucent panel and the opaque surface or panel. Applicants believe, therefore that Shofu and Detiker teach away from using a translucent and opaque panel without a light source between them. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See

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Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). MPEP 2141.02.

Additionally, the presence of an internal light source between panels could quite possibly defeat the shadow reduction purpose of the present invention. The absence of an internal light source does provide a simple solution to the reduction of shadows in a display device of the type described in the present invention. However, the fact that a simple solution has escaped other workers in the art is some evidence that it was not obvious to a person of ordinary skill in the art. See *In re Shelby*, 311 F.2d 807, 810, 136 USPQ 220 (CCPA 1963):

Appellant's claimed invention departs from the prior art in the direction of simplicity rather than in the direction of complexity. ... The simplicity of this useful invention is, in retrospect, some evidence that it was not obvious to a person of ordinary skill in the art. . . . *In re Osplack*, 39 CCPA 932, 195 F.2d 921, 93 USPQ 306. . . . While it is admittedly simple, it has escaped the other workers in this crowded art. We do not think the simplicity of appellant's construction should deprive him of his right to a patent thereon. *Expanded Metal Co. v. Bradford*, 214 U.S. 366.

Additional cited references are not relevant to the present invention.

The Examiner has also cited Stephan et al (2003/0064814), Cowell et al (US Pat. No. 6,662,503), and Slesinger et al (US 2002/0085373 A1) as being of interest. Applicants submit that these references are not relevant to the present invention.

Stephan discloses a "Gaming Machine Candle Device" that utilizes two transparent plates with LEDs between them. Frosting and beveling techniques used along the edges of the plates cause LED light to refract highlighting those areas. Stephan teaches away from the present invention by utilizing two transparent plates with a light source (LED) between the plates.

Cowell discloses a "Bath Enclosure Wall Panel" utilizing a laminate panel comprised of from three to eight layers of material, one such layer being frosted acrylic material (page 3, col. 3, line 46-57). Cowell teaches away from the present invention by utilizing three to eight layers of laminated material.

Slesinger discloses "Integrally Powered Modular Furniture" utilizing a translucent surface in front of an internal light source. Additionally there is no mention of a frosted panel in the disclosure.

Furthermore, the above-cited references do not address or recognize the problem solved by the claimed invention. Therefore it is respectfully submitted that Stephan, Cowell and Slesinger are not relevant to the present invention.

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In view of the Examiner's rejection of the claims, applicants have **CANCELLED claims 1-6**, without prejudice or disclaimer, and has **ADDED claims 7-21** to further include the limitations and clarification to overcome the cited art.

It is respectfully submitted that the new **claims 7-21** clearly and patentably distinguish over the cited art, since it is believed that the construction defined in these claims differs essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references. Applicant believes that combining the references discussed above would not lead to the claimed invention, in that the present invention does not merely employ the known substitution of equivalents but rather employs a new, non-obvious combination to accomplish the objectives set out in the present application.

As for the proposed combination of references cited by the examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined now in the new **claims 7-21**, and any hypothetical construction produced by this combination would not lead to applicants' invention.

In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the new **claims 7-21** and should be withdrawn. The new **claims 7-21** should be considered as patentably distinguishing over the cited art and should be allowed.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Respectfully submitted:

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